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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/565,983

Applicant(s)

NAKAMURA ET AL.

Examiner

ROBERT HANCE

Art Unit

4134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 12 and 15-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13, 14 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I (claims 1-11, 13-14 and 19) in the reply filed on 05/20/2008 is acknowledged.

Claim Objections

2. Claim 19 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. See MPEP § 608.01(n). Accordingly, the claim 19 has not been further treated on the merits. Claim 19 is further objected to because of the following informalities: claim 19 refers to ". . . the moving image distribution program according to claim 12 and/or the moving image dividing program according to claim 13 or 16 described therein." However, claim 12 is directed toward a moving image dividing system, claim 13 is directed toward a moving image distribution system, and claim 16 is directed toward a moving image dividing system. Appropriate correction is required.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), Annex IV, reads as follows:

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory).

In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

4. **Claim 11** is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claim 11 defines a program embodying functional descriptive material. However, the claim does not define a computer-readable medium or memory and is thus non-statutory for that reason (i.e., "When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized" – Guidelines Annex IV). That is, the scope of the presently claimed program can range from paper on which the program is written, to a program simply contemplated and memorized by a person.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 13 recites the limitation "said server provider server" in line 18. There is insufficient antecedent basis for this limitation in the claim. For purposes of examination, Examiner will assume that this is to read "said **service** provider server."

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-4 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berkson et al., US Pub No 2002/0148424 in view of Applicant's Admitted Prior Art (AAPA).

As to claim 1 Berkson et al. disclose a moving image distribution system for distributing a prespecified moving image to a user terminal connected to the system via a network such as the Internet (Abstract), said system comprising: an encrypting unit for encrypting the moving image file based on data for a CM file including a prespecified CM (advertisement) element incorporated therein (Abstract; Paragraphs 12 and 44; Figure 4 – video contains advertisement, which must be watched in order to view the

video. When an advertisement has expired, the viewer is forced to download an updated advertisement – i.e. the video is not complete and cannot be watched without this advertisement, and therefore the video is divided. See Fig. 2 reference numerals 1-5) a moving image distributing unit for distributing to the user terminal the moving image file produced by said encrypting unit together with the CM file in response to a request for reproduction from the user terminal previously storing therein either another one of the divided moving image files (Abstract; Paragraphs 12, 44 and 56; Figure 4 – user makes a request to view a piece of media content, and if the advertisement attached thereto has expired, the user must download and updated advertisement); and a reproducing unit for decrypting the two moving image files distributed to the user terminal based on the data of the CM file and reproducing the decrypted files (Paragraphs 12, 44; Figure 4 – video is first encrypted, and then later decrypted after the viewer has viewed the advertisement attached thereto. Therefore the video is decrypted based on the advertisement file. See Fig. 2 reference numerals 1-5).

Berkson et al. fail to disclose a moving image dividing unit for dividing said moving image into two not-reproducible moving image files along the time axis. However, in an analogous art, AAPA disclose dividing a moving image into two not-reproducible moving image files along the time axis (Paragraphs 6-7). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Berkson et al. with the teachings of AAPA by dividing the moving image file into two files along the time axis. The rationale for this combination would have been to enable the user to view the video smoothly like a downloaded file, but in a streaming

environment (see AAPA Paragraphs 6-7). All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

As to claim 2 Berkson et al. disclose a moving image distribution system for distributing a prespecified moving image to a user terminal connected to the system via a network such as the Internet (Abstract), said system having a service provider server comprising (Fig. 2); a main moving image file storing section for storing therein said main moving image file (Fig. 2: 22); a CM file storing section for storing therein a CM file including a prespecified CM element incorporated therein (Fig. 2: 23); and an encrypting unit for encrypting said main moving image file based on data of the CM file (Fig. 2: 27; Paragraphs 12, 44; Figure 4 – video is first encrypted, and then later decrypted after the viewer has viewed the advertisement attached thereto. Therefore the video is encrypted based on the advertisement file), wherein said service provider server receives a demand for distributing said moving image from said user terminal (Fig. 2: 21), summons said main moving image file corresponding to said moving image from said main moving image file storing section (Fig. 2: 22, 25; 27), and distributes said main moving image file to the user terminal (Fig. 2: 28), said service provider server receives a demand for reproducing said main moving image file from said user terminal (Fig. 4: 50 – user is forced to contact server to get new advertisement if the old advertisement has expired, therefore the user must submit a demand to the service

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provider server to reproduce the video), summons said CM file from said CM file storing section, and distributes said CM file (Fig. 4: 50; Fig. 5c; Paragraph 56), and said user terminal decrypts said distributed moving image files and said CM file with a prespecified reproducing unit and reproduces said moving image file (Paragraph 12, 44; Figs 5a-5c).

Berkson et al. fail to disclose a moving image dividing unit for dividing said moving image into two not-reproducible moving image files along the time axis, namely a main moving image file and a slave moving image file; a slave moving image file storing section for storing therein said slave moving image file; said service provider summons said slave moving image file corresponding to said main moving image file and encrypts said slave moving image file based on the data of said CM file, and distributes the encrypted slave moving image file to said user terminal together with said CM file. However, in an analogous art, AAPA discloses dividing a moving image into two not-reproducible moving image files along the time axis and distributing each of the video files (Paragraphs 6-7). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Berkson et al. with the teachings of AAPA by dividing the moving image file into two files along the time axis and encrypting the slave video file based on the advertisement file, and it would have been obvious to one of ordinary skill in the art at the time of the invention that this would also entail storing the slave video file on the server, and summoning the slave video file upon a reproduction request. The rationale for this combination would have been to improve security in network video distribution and enable the user to view the video

smoothly like a downloaded file, but in a streaming environment (see AAPA Paragraphs 6-7). All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

As to claim 3 Berkson et al. disclose a moving image distribution system for distributing a prespecified moving image to a user terminal connected to the system via a network such as the Internet (Abstract), said system comprising: a moving image contents provider server having said moving image (Fig. 5a), a sponsor server having a CM file with a prespecified advertisement element therein (Fig. 3: 33; Paragraph 50), and said moving image contents provider server having a main moving image file storing section for storing the main moving image file (Fig. 2: 22), an encrypting unit for encrypting said main moving image file based on data for said CM file (Paragraph 44), and a CM file storing section for storing therein said CM moving image distributed from the sponsor server (Fig. 2: 23), wherein said moving image contents provider server receives a demand for transmitting said moving image from said user terminal, summons said moving image from said main moving image file storing section, and distributes said moving image file to said user terminal (Paragraph 13; Fig. 2).

Berkson et al. fail to disclose a service provider server having a moving image dividing unit for dividing said moving image into two not-reproducible moving image files, namely a main moving image file and a slave moving image file, along the time axis; said moving image contents provider server having a main moving image file

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storing section for storing the main moving image file obtained after division by said moving image dividing unit; said service provider server having a slave moving image file storing section for storing therein the slave moving image file obtained after division by said moving image dividing unit; said service provider server receives a demand for reproducing said main moving image file from said user terminal and summons said slave moving image file corresponding to said main moving image file and said CM file from said slave moving image file storing section of said service provider server and said CM file storing section, and said service provider further encrypts said slave moving image file through said encrypting unit based on the data thereof, and distributes the encrypted slave moving image file to said user terminal together with said CM file, and said user terminal decrypts two of the distributed moving image files and said CM file by a pre-specified reproducing unit and reproduces said moving image files.

However, AAPA discloses a moving image dividing unit for dividing said moving image into two not-reproducible moving image files along the time axis (Paragraphs 6-7); and it would have been obvious to one of ordinary skill in the art that, after dividing a video file, said moving image contents provider server would have a main moving image file storing section for storing the main moving image file obtained after division by said moving image dividing unit and said service provider server having a slave moving image file storing section for storing therein the slave moving image file obtained after division by said moving image dividing unit. AAPA also discloses said service provider server receives a demand for reproducing said main moving image file from said user

terminal and summons said slave moving image file corresponding to said main moving image file from said slave moving image file storing section of said service provider server, and said service provider further encrypts said slave moving image file through said encrypting unit, and distributes the encrypted slave moving image file to said user terminal, and said user terminal decrypts two of the distributed moving image files by a pre-specified reproducing unit and reproduces said moving image files (Paragraphs 6-9).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Berkson et al. with the teachings of AAPA by dividing the moving image file into two files along the time axis and encrypting the slave video file based on the advertisement file, and it would have been obvious to one of ordinary skill in the art at the time of the invention that this would also entail storing the slave video file on the server, and summoning the slave video file upon a reproduction request. The rationale for this combination would have been to improve security in network video distribution and enable the user to view the video smoothly like a downloaded file, but in a streaming environment (see AAPA Paragraphs 6-9). It would furthermore have been obvious to one of ordinary skill in the art to modify the teachings of Berkson et al. with the teachings of AAPA by distributing an advertisement file along with the slave video file. The rationale for this modification would have been to allow for advertisement revenue for the video distributor. All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would

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have yielded predictable results to one of ordinary skill in the art at the time of the invention.

As to claim 4 Berkson et al. fail to disclose the moving image distribution system according to claim 1, wherein said moving image dividing unit compresses data for the moving image file so that a total of file capacities of the two moving image files is smaller than a file capacity for the moving image. However, examiner takes official notice of the fact that compressing a moving image file before distribution over a network is a method that was commonly known in the art at the time of the invention. It would have been obvious to one of ordinary skill in the art at the time of the invention to compress the divided moving image files. The rationale for this combination would have been to decrease file size in order to increase transmission speed. All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Berkson et al. fail to disclose that said moving image dividing unit divides the moving image so that a file capacity of said main moving image file is larger than that of said slave moving image file. However, in light of the teachings of Berkson et al. it would have been obvious to one of ordinary skill in the art to divide the moving image file such that the main image file is larger than the slave image file. In this manner, when a user requests to view the video and must download the slave image file along with the advertisement, the amount of time the user would have to wait in order to view

the video file would be greatly decreased. Just as Berkson et al. disclose that the user must download an advertisement (which would be a short, fast download), it would have been apparent to one of skill in the art that it would be optimal to have the slave video file be as small as possible while still maintaining the security advantage of AAPA. All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

As to claim 11 see similar rejection to claim 1. The program of claim 11 corresponds to the system of claim 1, therefore claim 11 has been analyzed and rejected.

9. Claims 5, 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berkson et al., US Pub No 2002/0148424 in view of Applicant's Admitted Prior Art (AAPA) and further in view of Zhu et al., US Pub No 2004/0196975.

As to claim 5 Berkson et al. as modified fail to disclose that said encrypting unit computes an exclusive logical sum (XOR) of a data bit array for said CM file and a data bit array for said divided moving image file and encrypts for encrypting said moving image file. However, in an analogous art, Zhu et al. disclose encrypting a video file by computing an exclusive logical sum (XOR) of a data bit array in an enhancement layer and a bit array in a base layer (claim 92). It would have been obvious to one of ordinary skill in the art to modify the teachings of Berkson et al. as modified with the teachings of Zhu et al. The rationale for this modification would have been to encrypt the video files

such that they can only be played once the advertisement has been viewed. All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

As to claim 8 Berkson et al. as modified disclose the moving image distribution system according to claim 1, wherein said reproducing unit comprises a decoder for decoding said main moving image file to said reproducible moving image (Paragraph 44 – encryption is used, therefore the reproducing unit must decode the video file); said reproducing unit encrypts said CM file and said moving image files by said encrypting unit after checking that the said CM file has been reproduced, and starts up said decoder to decode said main moving image file and said slave moving image file to said reproducible moving image (Paragraphs 12 and 44; Fig. 4).

Berkson et al. fail to disclose a decrypting unit for decrypting said encrypted moving image files together with the CM file again by executing the exclusive logical sum (XOR) processing. However, in an analogous art, Zhu et al. disclose decrypting encrypted multimedia data by computing the XOR of a bit array from a base layer and a bit array from an enhancement layer of a video file. It would have been obvious to one of ordinary skill in the art to modify the teachings of Berkson et al. as modified with the teachings of Zhu et al. The rationale for this modification would have been to encrypt the video files such that they can only be played once the advertisement has been viewed. All the claimed elements were known in the prior art and one skilled in the art

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could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Berkson et al. as modified by Zhu et al. fail to disclose a decoder for decoding said main moving image file and said slave moving image. However, AAPA discloses dividing a video file along the time axis before distribution to a viewer (Paragraphs 6-7). It would have been obvious to one of ordinary skill in the art to modify the teachings of Berkson et al. as modified with the teachings of AAPA. The rationale for this modification would have been to enable the user to view the video smoothly like a downloaded file, but in a streaming environment (see AAPA Paragraphs 6-7). All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

As to claim 10 Berkson et al. as modified fail to disclose the moving image distribution system according to claim 8, wherein said reproducing unit further comprises a user information storing section for storing therein user information concerning said user, and distributes said user information to said user information storing section in said service provider server in response to a demand from an user certifying engine. However, examiner takes official notice of the fact that storing user information on a client device, and distributing this information to a server in response to a certification request, were well known in the art at the time of the invention.

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Remembering usernames and passwords and thus allowing a user to quickly access material without having to enter his/her information was and is a commonly known technique. It would have been obvious to one of ordinary skill in the art to modify the teachings of Berkson et al. as modified to include automatic user information transmittal. The rationale for this modification would have been to allow a user to more quickly and conveniently access material by removing the need to continually enter a username and password. All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

10. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berkson et al., US Pub No 2002/0148424 in view of Applicant's Admitted Prior Art (AAPA) and further in view of Hitson et al., US Pub No 2002/0010759.

As to claim 6 Berkson et al. as modified fail to disclose the moving image distribution system according to claim 1 further comprising: a user information storing section for storing therein various types of user information concerning users including service providers (managers), users, moving image contents providers, and sponsors; and a user certifying engine for certifying access to said service provider server based on said user information, wherein said moving image dividing unit acknowledges a demand for dividing said moving image only when a user is authenticated as e the service provider or e the moving image contents provider by said user certifying engine.

However, in an analogous art, Hitson et al. disclose a server having stored thereon multimedia content which can be accessed and edited by administrators, users, advertisers and content providers. It would have been obvious to one of ordinary skill in the art at the time of the invention that access to this material should be password protected, and access should be given only to authenticated users, in order to prevent malicious activity. It would have been obvious to one of ordinary skill in the art to modify the teachings of Berkson et al. as modified with the teachings of Hitson et al. The rationale for this modification would have been to allow content providers, advertisers, etc., to access the content stored on the server, in order to allow for greater flexibility in what content is provided to users. All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

11. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berkson et al., US Pub No 2002/0148424 in view of Applicant's Admitted Prior Art (AAPA) and further in view of Okayama et al., US Pub No 2002/0053090.

As to claim 7 Berkson et al. as modified fail to disclose the moving image distribution system according to claim 2, wherein said service provider server furthermore comprises a CM file summoning unit for summoning said CM file from said CM file storing section based on said user information, and said CM file summoning unit

selects a CM file demanded by the user from the CM file storing section based on the user information and provides the CM file to said encrypting unit.

However, in an analogous art, Okayama et al. disclose distributing targeted advertisement to viewers, where the targeting is based on viewer profiles stored within a server (Paragraph 321). It would have been obvious to one of ordinary skill in the art to modify the teachings of Berkson et al. as modified with the teachings of Okayama et al. The rationale for this modification would have been to present viewers with advertising that more closely matches their profiles, thus increasing the impact of the advertisements. All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

12. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berkson et al., US Pub No 2002/0148424 in view of Applicant's Admitted Prior Art (AAPA) and further in view of Zhu et al., US Pub No 2004/0196975 and further in view of Teng et al., US Patent No 6,094,679.

As to claim 9 Berkson et al. as modified fail to disclose the moving image distribution system according to claim 8, wherein said service provider server comprises a reproducing unit storing section for storing therein said reproducing unit, and executes a processing procedure comprising a searching step of searching, when a demand for reproduction of said main moving image file is received from said user terminal, whether

said reproducing unit is present on said user terminal or not, and said reproducing unit is distributed to said user terminal when it is determined in the searching step that there is no reproducing unit on said user terminal.

However, in an analogous art, Teng et al. disclose an updating service which polls client devices to determine whether or not their software is up to date, and automatically distributes updated software to clients that need it (col. 2 lines 4-20). It would have been obvious to one of ordinary skill in the art to modify the teachings of Berkson et al. as modified with the teachings of Teng et al. The rationale for this modification would have been to ensure that the client possesses the proper reproduction software needed to view the video file. All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

13. Claims 13 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berkson et al., US Pub No 2002/0148424 in view of Applicant's Admitted Prior Art (AAPA) and further in view of Shintani et al., US Pub No 2002/0124249.

As to claim 13 Berkson et al. disclose a moving image distribution system for distributing a prespecified moving image to a user terminal connected to the system via a network such as the Internet (Abstract), said system comprising: a service provider server, wherein said service provider server comprises: an encrypting unit for encrypting

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the moving image file based on data for a CM file (Abstract; Paragraphs 12 and 44; Figure 2: 23; Figure 4 – video contains advertisement, which must be watched in order to view the video. When an advertisement has expired, the viewer is forced to download an updated advertisement – i.e. the video is not complete and cannot be watched without this advertisement, and therefore the video is divided. See Fig. 2 reference numerals 1-5); a moving image distributing unit for distributing to the user terminal the moving image file produced by said encrypting unit together with the CM (Abstract; Paragraphs 12, 44 and 56; Figure 4 – user makes a request to view a piece of media content, and if the advertisement attached thereto has expired, the user must download and updated advertisement).

Berkson et al. fail to disclose a moving image dividing unit for dividing a moving image distributed from a moving image contents provider into two not-reproducible moving image files, namely a main moving image file and a slave moving image file along the time axis. However, in an analogous art, AAPA disclose dividing a moving image into two not-reproducible moving image files along the time axis (Paragraphs 6-7). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Berkson et al. with the teachings of AAPA by dividing the moving image file into two files along the time axis. The rationale for this combination would have been to enable the user to view the video smoothly like a downloaded file, but in a streaming environment (see AAPA Paragraphs 6-7). It would also have been obvious to one of ordinary skill in the art at the time of the invention that this moving image would have been distributed from a moving image contents provider.

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All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Berkson et al. fail to disclose that the CM file is distributed from a sponsor. However, examiner takes official notice of the fact that advertisements distributed from a sponsor were well known in the art at the time of the invention. It would have been obvious to one of ordinary skill in the art at the time of the invention to receive advertisements from a sponsor. The rationale for this would have been to allow sponsors to distribute their advertisements to the server. All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Berkson et al. as modified fail to disclose that said server [service] provider server also presents a CM advertisement fee associated with distribution of said moving image file to said sponsor. However, in an analogous art, Shintani et al. disclose billing a sponsor based on the number of times an advertisement is provided to users (Paragraph 12). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Berkson et al. as modified with the teachings of Shintani et al. The rationale for this combination would have been to only charge advertisers for advertisements that are actually viewed by users, and thus making

advertising more attractive to potential sponsors. All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

As to claim 19 see similar rejection to claim 13.

14. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berkson et al., US Pub No 2002/0148424 in view of Applicant's Admitted Prior Art (AAPA) and further in view of Heckel, US Patent No 6,036,601.

As to claim 14 Berkson et al. disclose a moving image contents provider server storing therein said moving image (Fig. 2: 22); a sponsor server storing therein a CM file with a prespecified advertisement element therein (Fig. 2: 23); a service provider server, having: an encrypting unit for encrypting the moving image file based on data for a CM file (Abstract; Paragraphs 12 and 44; Figure 2: 23; Figure 4 – video contains advertisement, which must be watched in order to view the video. When an advertisement has expired, the viewer is forced to download an updated advertisement – i.e. the video is not complete and cannot be watched without this advertisement, and therefore the video is divided. See Fig. 2 reference numerals 1-5); a moving image distributing unit for distributing to the user terminal the moving image file produced by said encrypting unit together with the CM (Abstract; Paragraphs 12, 44 and 56; Figure

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4 – user makes a request to view a piece of media content, and if the advertisement attached thereto has expired, the user must download and updated advertisement).

Berkson et al. fail to disclose a moving image dividing unit for dividing a moving image distributed from a moving image contents provider into two not-reproducible moving image files, namely a main moving image file and a slave moving image file along the time axis. However, in an analogous art, AAPA disclose dividing a moving image into two not-reproducible moving image files along the time axis (Paragraphs 6-7). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Berkson et al. with the teachings of AAPA by dividing the moving image file into two files along the time axis. The rationale for this combination would have been to enable the user to view the video smoothly like a downloaded file, but in a streaming environment (see AAPA Paragraphs 6-7). It would also have been obvious to one of ordinary skill in the art at the time of the invention that this moving image would have been distributed from a moving image contents provider. All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Berkson et al. as modified fail to disclose that said service provider server further comprises a CM management engine including a counting section for counting number of times of distribution of either one or both of said main and slave moving image files; a CM distribution managing section for managing log data for distribution of said CM file

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distributed together with said moving image file; and a CM information preparing section for computing distribution information for said CM file according to the number of times of distribution of said CM file and the distribution log data; and said counting section counts the number of times of distribution of said distributed moving image contents in response to a demand for distribution from said user terminal said CM information preparing section summons the number of times of counting from said counting section, and said distribution data from said CM distribution managing section at the same time, and prepares CM distribution information from said number of times of counting and the distribution data in and notifies said moving image contents provider and/or said sponsor server of said CM distribution information.

However, in an analogous art, Heckel discloses counting and logging the number of times an advertisement is viewed, and downloading these statistics to an advertiser (col. 3 lines 4-16; col. 5 lines 14-17). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Berkson et al. as modified with the teachings of Heckel. The rationale for this combination would have been to present an advertiser with an accurate summary of advertisement viewing statistics, and to bill advertisers based on this information. All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT HANCE whose telephone number is (571)270-5319. The examiner can normally be reached on M-F 8:00am - 5:00am EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, LunYi Lao can be reached on (571) 272-7671. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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